



UNITED STATES PATENT AND TRADEMARK OFFICE

HC
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,984	08/30/2001	Susumu Takahashi	950088B	7633

23850 7590 04/23/2003

ARMSTRONG, WESTERMAN & HATTORI, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 04/23/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,984

Applicant(s)

TAKAHASHI ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 10-13, 19, 22, 23, 35-38, 40, 44, 49-53, 55 and 56 is/are pending in the application.
- 4a) Of the above claim(s) 10-13, 22, 23, 35-38, 40, 44, 49-53, 55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/053,094.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3739

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1, 2, 4 and 19 in Paper No. 5 is acknowledged. Since claims 10-13, 22, 23, 35-38, 40, 49 and 50 still depend from canceled claims, these claims are included in the claims being withdrawn from consideration. Because these claims are also indefinite, they should be canceled.

Specification

2. The disclosure is objected to because of the following informalities: Reference U.S. Pat. 5,743,890 in the priority data is incorrect. It should be 5,743,846.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 2, "said optical axis" and "the optical axis of said image transmitting optical system" lack antecedent basis.

As to claim 4, "said object side" lacks antecedent basis.

Claim Rejections - 35 USC § 102

Art Unit: 3739

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Jap. Pat. 4-16812.

Figure 1 discloses an endoscope including an elongate insertion section (2), an illuminating light projecting means (6,9), an objective optical system at the distal end having two optical systems (13a,13b) forming two images with parallax, and one image transmitting optical system (14). The two optical systems are arranged in parallel and include negative lenses (Fig.1). An optical system (17) is arranged in common on the image side of the optical systems.

7. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Akui et al. (U.S. Pat. 5,577,991).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

Art Unit: 3739

inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Referring mainly to Figure 19, Akui et al. discloses an elongate inserted section (69), an illuminating light projecting means (col.5, lines 8-11), an objective optical system arranged on the distal end having two optical systems (64,64) formed of negative lenses and forming two images with parallax and having optical axes that are eccentric from the optical axis of a image transmitting optical system (proximal part of 65), the image transmitting optical system transmits the two images in common, and a optical system (either the positive lenses of 64, the prisms 63a and 63b or distal-most lens of 65) arranged in common on the image side of the two optical systems.

8. Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. (U.S. Pat. 5,720,706).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Referring mainly to Figures 3-6, Takahashi et al. disclose an elongate inserted section (22), an illuminating light projecting means (col.5, lines 1-3), an objective optical system (5) arranged on the distal end and forming four images having parallax between each other (note

Figs.4-6 and col.7, lines 1-21), one image transmitting optical system (6), an image taking means (25) and a display means (33a,33b,28,29) for selectively displaying any two images in at least one display means.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Czarnek et al. (U.S. Pat. 5,613,936)--note two optical systems having parallax and one common transmitting optical system.

Hasegawa (U.S. Pat. 4,941,457)--note Figure 18. Image guides (26) and (26') would meet the limitation of one image transmitting optical *system*.

Jap. Pat. 60-241017--note teaching in Figures 1 and 2 as applicable to claims 1 and 4, wherein two separate image transmission optical systems is replaced with a single image transmission optical system; in addition, negative lenses and a single common optical system (4b) is used.

Other references showing the state of the art are Takahashi (U.S. Pat. 5,776,049) and Takahashi (U.S. Pat. 5,689,365).

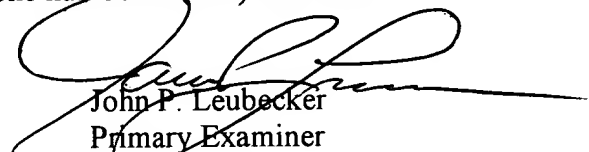
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951.

The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

Art Unit: 3739

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl
April 16, 2003